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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,773	11/30/2001	Yasushi Hara	Q67446	4591

7590 03/05/2003

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 03/05/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-5

Office Action Summary

Application No.

09/996,773

Applicant(s)

HARA ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, and 6-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Abe et al (US 6,323,169).

Abe teaches compositions containing 0.0001-60% hydrogen peroxide (see col. 2, lines 50-60), 0.001-10% quaternary ammonium compounds (see col. 3, lines 35-45 and col. 4, lines 16-23), amine based chelating agents (see col. 3, lines 1-17), and the balance being water.

Concerning claim 10, the combination of hydrogen peroxide with the quaternary ammonium compounds taught by Abe would inherently form quaternary ammonium peroxyhydrates as reaction products and would thus contain the peroxyhydrates. A description

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of this reaction can be found in Snoble (US 4,655,975; see col. 3, lines 9-31) noting that Snoble teaches the precipitation of peroxyhydrates occurring under ambient conditions.

Concerning claim 11, Abe teaches the addition of various organic solvents (see col. 3, lines 45-68) including dimethyl sulfoxide.

Concerning the intended use, as all material limitations of claim 1 have been met, such intended uses as found in claims 18-19 would be inherent to these composition as composition with identical compounds would perform identical functions.

Claims 1-3, 6-16, 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakizawa et al (US 6,410,494).

Kakizawa teaches semiconductor cleaning compositions containing 0-25% tetramethyl ammonium hydroxide (see cols. 2-3), organic amines (see col. 3, lines 23-34), chelating agents (see col. 4), glycol ether surfactants (see col. 3, lines 35-56), and hydrogen peroxide (see col. 4, lines 21-30).

Concerning claim 10, the combination of hydrogen peroxide with the quaternary ammonium compounds taught by Abe would inherently form quaternary ammonium peroxyhydrates as reaction products and would thus contain the peroxyhydrates. A description of this reaction can be found in Snoble (US 4,655,975; see col. 3, lines 9-31) noting that Snoble teaches the precipitation of peroxyhydrates occurring under ambient conditions.

Claims 1, 2, 4-8, 10, 12, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Philippe et al (JP 01165524A).

Philippe et al teaches compositions containing benzoyl peroxide and tetralkyl quaternary ammonium carbonates wherein the carbonate is salicylic acid (see abstract).

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Conclusion

Although all of the applicant's claims have been rejected, it should be noted that the examiner found very few references that contain the applicant's compounds of instant claim 5 in combination with the peroxide. The instant claims however do not exclude additional ingredients such as would be found in cosmetic compositions. The term "comprises" allows for the prior art to teach additional ingredients and still read on the instant claims. It is suggested that the applicant claim a composition "consisting of" or "consisting essentially of" the peroxide and the compound of claim 5. If the applicant chooses the term "consisting essentially of", it is the applicant's burden to demonstrate via evidence that any additional compounds taught by the prior art would have a detrimental effect. The second option is for the applicant to define ranges of each of these compounds that would exclude prior art compositions.

Skee, Morinaga et al, Skee et al were cited to demonstrate the current state of the art in semiconductor cleaning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 703-308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read 'Gregory E. Webb', with a stylized, flowing script.

Gregory E. Webb
Primary Examiner
Art Unit 1751

gw
March 3, 2003